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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/987,159	11/13/2001	Linus Wiebe	3782-0198P	6434

2292 7590 03/25/2005

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EXAMINER

CHARLES, DEBRA F

ART UNIT	PAPER NUMBER
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3624

DATE MAILED: 03/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/987,159

Applicant(s)

WIEBE ET AL.

Examiner

Debra F. Charles

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 January 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6 and 26-49 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 6 and 26-49 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/28/2004.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Response to Amendment

1. Claims 1-5 and 7-25 are cancelled. Claims 26-49 have been added.

Response to Arguments

2. In response to the attorney's changes in the specification, the examiner's objections to the specification are being reversed.
3. Applicant's arguments with respect to claims 6 and 26-49 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 6, 48 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman et al.(6330976) and Harrison et al.(6176425B1).

Re claim 6: Dymetman disclose a method in a hand-held device(Abstract, Fig. 8, 11, col. 20, lines 40-45) for initiating an operation concerning goods or services indicated on a product, comprising the steps of receiving a position-coding pattern from the product, of identifying, by means of coordinates coded by the position-coding pattern(col. 3, lines 20-40), and of making possible the carrying out of the operation by communication with a network-based system(col. 4, lines 45-67).

Dymetman disclose(s) the claimed invention except an instruction from a person who uses the device to the effect that the operation is to be carried out using person-specific information previously stored in the system. However, in Abstract, Fig. 7, col. 2, lines 55-col. 4, line 10 thereof, Harrison et al. disclose(s) the device user retrieving personal information from a database and a database stores previously entered information. It would be obvious to one of ordinary skill in the art to modify the invention of Dymetman based on the teachings of Harrison et al. The motivation to combine these references is to provide a storage capacity for the retrieval of data entered via pen-based computing system.

Re claims 48 and 49: Dymetman disclose a server for processing a payment operation, and a computer-readable medium containing instructions, executed by a processor (col. 17, lines 35-65, col. 33, lines 35-60) in a network-based system(col. 4, lines 45-67), initiated by a handheld device and a product(Abstract, Fig. 8, 11, col. 20, lines 40-45), which and at least one area comprising a position code coding absolute positions, each position being coded by a predetermined plurality of marks and each mark contributing to the coding of a plurality of positions(col. 17, lines 35-65, col. 33, lines 35-60), the server comprising:

a processor(col. 6, lines 20-41); and

memory(col. 7, lines 1-15), functionally coupled to the processor, containing executable instructions for receiving(col. 7, lines 1-15), from the handheld device,

least one absolute position on the basis of marks included in a subset of the position code recorded by the handheld device(col. 7, lines 40-65),

establishing, the basis of the said least one absolute position,

that a payment operation is to be carried out(col. 17, lines 35-65, col. 33, lines 35-60),

and identifying, on the basis of the said at least one absolute position, said item for which the payment is to be carried out(col. 17, lines 35-65, col. 33, lines 35-60).

Dymetman disclose the invention except which is provided with human-understandable information about an item for which payment is to be carried out. However, in Abstract, Fig. 7, col. 2, lines 55-col. 4, line 10 thereof, Harrison et al. disclose(s) the device user retrieving personal information from a database and a database stores previously entered information. It would be obvious to one of ordinary skill in the art to modify the invention of Dymetman based on the teachings of Harrison et al. The motivation to combine these references is to provide a storage capacity for the retrieval of data entered via pen-based computing system.

6. Claims 26,27,28, 29,33,34,35,36,37,38,39,40,44,46, 45 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Dymetman, Harrison et al., Lazzouni et al.(5652412), and Silverbrook et al.(6832717).

Re claims 26 and 37: Dymetman disclose a method of initiating payment operation(col. 17, lines 35-65, col. 33, lines 35-60) in a network-based system(col. 4, lines 45-67), by using handheld device and product(Abstract, Fig. 8, 11, col. 20, lines 40-45).

identifying, on the basis of the said at least one absolute position, that a payment operation to be carried out(col. 17, lines 35-65, col. 33, lines 35-60); and

identifying, on the basis of the said at least one absolute position, said item for which the payment is to be carried out(col. 17, lines 35-65, col. 33, lines 35-60).

Dymetman disclose the invention except which is provided with human-understandable information about an item for which payment is to be carried out. However, in Abstract, Fig. 7, col. 2, lines 55-col. 4, line 10 thereof, Harrison et al. disclose(s) the device user retrieving personal information from a database and a database stores previously entered information. It would be obvious to one of ordinary

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skill in the art to modify the invention of Dymetman based on the teachings of Harrison et al. The motivation to combine these references is to provide a storage capacity for the retrieval of data entered via pen-based computing system.

Dymetman and Harrison et al. disclose the invention except at least one area comprising a position code coding absolute positions by markings that are displaced from respective nominal positions defined by intersections of grid lines in a regular grid, and recording, by the handheld device, a subset of the position code coding at least one absolute position. However, in the Abstract, Fig. 12, 13, col. 2, line 35-col. 3, line 35, thereof Lazzouni et al. disclose a grid that has encoded, optically readable position information which identifies a coordinate position on the writing surface. It would be obvious to one of ordinary skill in the art to modify the invention of Dymetman and Harrison et al. based on the teachings of Lazzouni et al. The motivation to combine these references is to provide a storage capacity for the retrieval of data entered via pen-based computing system.

Dymetman, Harrison et al. and Lazzouni et al. disclose the invention except determining said at least one absolute position by determining the displacements of the markings from the nominal positions in the recorded part of the position code. However, in the Abstract, claim 169, thereof Silverbrook et al. disclose operative position relative to interface surface, sensing device generates movement data indicative of the sensing device's movement relative to the interface surface and displacement effectively ascertaining a locus of the sensing means in relation to the surface by ascertaining relative displacement of the sensing device due to its velocity within each sampling period. It would be obvious to one of ordinary skill in the art to modify the invention of Dymetman, Harrison et al. and Lazzouni et al. based on the teachings of Silverbrook et al. The motivation to combine these references is to provide a storage capacity for the retrieval of data entered via pen-based computing system.

Re claims 27 and 38: Dymetman disclose wherein the identifying that a payment operation is to be carried out is carried out in the handheld device(col. 17, lines 35-65, col. 33, lines 35-60).

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Re claims 28 and 39: Dymetman disclose the identifying that a payment operation is to be carried out carried out in an external unit(col. 17, lines 35-65, col. 33, lines 35-60).

Re claim 29 and 40: Dymetman disclose comprising sending a unique identity of the handheld device to the network-based system to enable the payment operation to be carried out(col. 4, lines 45-67, col. 17, lines 35-65, col. 33, lines 35-60).

Re claims 33, 34, 44 and 45. Dymetman disclose the invention except further comprising recording graphical information specifying the payment operation by means of the position code and sending the graphical information from the handheld device to the network-based system to enable the payment operation to be carried out. However, in the Abstract, Fig. 12, 13, col. 2, line 35-col. 3, line 35, thereof Lazzouni et al. disclose a grid that has encoded, optically readable position information which identifies a coordinate position on the writing surface. It would be obvious to one of ordinary skill in the art to modify the invention of Dymetman and Harrison et al. based on the teachings of Lazzouni et al. The motivation to combine these

references is to provide a storage capacity for the retrieval of data entered via pen-based computing system.

Re claims 35 and 46: Dymetman disclose the invention except further comprising sending absolute positions decoded from the position code on the product to the network-based system to enable the payment operation to be carried out. However, in the Abstract, Fig. 12, 13, col. 2, line 35-col. 3, line 35, thereof Lazzouni et al. disclose a grid that has encoded, optically readable position information which identifies a coordinate position on the writing surface. It would be obvious to one of ordinary skill in the art to modify the invention of Dymetman and Harrison et al. based on the teachings of Lazzouni et al. The motivation to combine these references is to provide a storage capacity for the retrieval of data entered via pen-based computing system.

Re claims 36 and 47: Dymetman disclose the invention except wherein the recording is carried out by ticking said at least one area. However, in the Abstract, Fig. 12, 13, col. 2, line 35-col. 3, line 35, thereof Lazzouni et al. disclose a grid that has encoded, optically

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readable position information which identifies a coordinate position on the writing surface. It would be obvious to one of ordinary skill in the art to modify the invention of Dymetman and Harrison et al. based on the teachings of Lazzouni et al. The motivation to combine these references is to provide a storage capacity for the retrieval of data entered via pen-based computing system.

7. Claims 30 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman as applied to claims 29 and 40 above, and further in view of Suliman, Jr. et al.(2001/0053980).

Re claims 30 and 41: Dymetman disclose the invention except wherein the unique identity is associated with at least one account number. However, in claim 27, thereof, Suliman, Jr. et al. disclose specific identities associated with at least one account number. It would be obvious to one of ordinary skill in the art to modify the invention of Dymetman based on the teachings of Suliman, Jr. et al. The motivation to combine these references is to provide a storage

capacity for the retrieval of data entered via pen-based computing system.

Claims 31 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman as applied to claims 26 and 37 above, and further in view of Abel et al.(5852809).

Re claims 31 and 42. Dymetman disclose the invention except further comprising sending an indication of an account number stored.

However, in col. 13, lines 30-45, col. 16, lines 5-40, Abel et al. disclose sending data from point to point and storing it. It would be obvious to one of ordinary skill in the art to modify the invention of Dymetman based on the teachings of Abel et al. The motivation to combine these references is to provide a storage capacity for the retrieval of data entered via pen-based computing system.

Claims 32 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dymetman as applied to claims 26 and 37 above, and further in view of Denver(2002/0023029).

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Re claims 32 and 43: Dymetman disclose the invention except further comprising identifying payment recipient. However, in para. 007 and claim 10, Denver disclose credit receipt which is the same as payment receipt and solves the same problem. It would be obvious to one of ordinary skill in the art to modify the invention of Dymetman based on the teachings of Denver. The motivation to combine these references is to provide a storage capacity for the retrieval of data entered via pen-based computing system.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

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calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra F. Charles whose telephone number is (703) 305-4718. The examiner can normally be reached on 9-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent A. Millin can be reached on (703) 308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



VINCENT MILLIN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Debra F. Charles
Examiner
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